

REMARKS

At the time of the Third Office Action dated April 16, 2009, claims 1-33 were pending and rejected in this application.

CLAIMS 1-22 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 2-4 of the Third Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-22, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed.

Claims 1 and 5

Although Applicants disagree with the Examiner's implied assertion that independent claims 1 and 5 are not directed to statutory subject matter, independent claims 1 and 5 have been amended to recite that the claimed analyzing step is performed in an e-mail computer hardware system. As such, at the very least, independent claims 1 and 5 is tied to a machine and meets the 'machine or transformation' test described within In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc).

Claims 12 and 16

Although Applicants disagree with the Examiner's implied assertion that independent claims 12 and 16 are not directed to statutory subject matter, independent claims 12 and 16 have been amended to recite various computerized means, which are components of a hardware

1 system capable of performing the claimed function. Thus, the claimed computerized system
2 includes devices and meets the requirements of 35 U.S.C. § 101.

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4 For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed
5 rejection of claims 1-22 under 35 U.S.C. § 101.

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7 **CLAIMS 23-33 ARE REJECTED UNDER THE FIRST PARAGRAPH OF 35 U.S.C. § 112**

8 On pages 4 and 5 of the Third Office Action, the Examiner asserted that the claims
9 contain subject matter not in the possession of Applicants at the time the application was filed.
10 This rejection is respectfully traversed.

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12 Specifically, the Examiner asserted the following:

13 The claims contain subject matter which was not described in the specification in such a way as to
14 reasonably convey to one skilled in the relevant art that the inventors, at the time the application
15 was filed, had possession of the claimed invention. The claims recite the phrase "a computer-
16 readable storage medium ..." not found in the specification. It is however appreciated that the
17 language in question here was present in the claims as originally filed.
18

19 At the outset, Applicants are incredulous the Examiner would make such a baseless
20 rejection. As correctly noted by the Examiner, the originally-filed claims already included the
21 phrase "computer-readable storage medium." Original claims constitute their own description. In
22 re Koller, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). As such, the originally-filed application
23 provides support for the phrase "computer-readable storage medium." Applicants also note that
24 over twelve thousand, five hundred issued U.S. patents have at least one claim that includes the
25 exact phrase "computer readable storage medium." As such, Applicants respectfully submit that

1 those skilled in the art would have no problem making and using the claimed invention based
2 upon the terminology used.

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4 For the above-described reasons, Applicants respectfully solicit withdrawal of the imposed
5 rejection of claims 23-33 under the first paragraph of 35 U.S.C. § 112.

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Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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